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IN THE

Supreme Court of the United States

OCTOBER TERM 1967

No. 926

JOSEPH SCHMIDINGER and TUNG-SOL ELECTRIC, INC.,

Petitioners,

v.

MARIE J. WELSH, JAMES W. WELSH and WELFLASH, INC., OXFORD ELECTRIC CORPORATION and its HUDSON LAMP DIVISION, HUDSON LAMP CO., INC., BEST MFG. CO., and its HUDSON LAMP CO., INC., DIVISION,

Respondents.

REPLY BRIEF TO BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

STATEMENT OF THE CASE

An omission appears in the respondents' statement of the case which is hereby corrected.

In the last paragraph at page 3 of respondents' brief, it is alleged that during Patent Office prosecution of the application that resulted in the '023 reissue patent in suit claims

covering the respondents' structure (with support attached to buckling member) were rejected by the Patent Office and Schmidinger acquiesced in the rejection and cancelled such claims from his application.

In making this statement, respondents have ignored the fact that Schmidinger in continuing prosecution of the reissue application achieved the allowance of broad reissue claims 25 and 26 which encompass the subject matter of the cancelled claims within their scope. On this point the District Court stated at (A55)*:

> "As to the support, Schmidinger obtained in claim 26, as well as in claim 25, the allowance of a claim with no limitation to, or even mention of, a support. For these reasons, the Court finds that file wrapper estoppel is not present in this case." (Also see A 68-70)

The mere fact of persisting in the prosecution to the final allowance of the broad reissue patent claims 25 and 26 refutes any acquiescence on the part of Schmidinger in the Patent Office rejection referred to by the respondents.

Aside from this important omission, the respondents agree with petitioners' statement of the case and the fact that the issue of file wrapper estoppel centers on the question as to whether the doctrine of file wrapper estoppel, which imputes to a patentee abandonment of all that is surrendered when a broad claim is cancelled in order to obtain the allowance of a narrower claim over the prior art, should be applied when a narrow claim is cancelled in favor of the allowance of a broad patent claim which embraces the substance of the narrow cancelled claim within its scope.

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*Page reference to appendix of Petition for Writ of Certiorari No. 926.

ARGUMENT

(a) Validity

The respondents at pages 4 and 5 of their argument have cited decided cases in support of the proposition that a combination claim to be valid must include all the elements necessary for an operative structure. These cases are in direct conflict with the clear holding of the decided cases set forth at pages 6 and 7 of the Petition for Writ of Certiorari and this conflict certainly provides an added rason as to why the petition should be granted.

If the Court below was correct in its interpretation of the Supreme Court decisions in *Graham* v. *John Deere,* 383 U. S. 1 (1966) and *Aro Manufacturing Co.* v. *Convertible Top,* 365 U. S. 336 (1961), then it would be a requirement under our patent laws that all the elements necessary for an operable structure be set forth in a subcombination claim. But this is in direct conflict with the statutory provisions of 35 U. S. C. 112.

Under 35 U. S. C. 112 an applicant is directed to include in his patent application "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention". There is no requirement here to claim an operable structure and indeed the loading of a claim with old elements not of the applicant's invention but necessary for an operable structure would only obscure the contribution to the art which the applicant claims as his invention. Clarity in claims brought about by "particularly pointing out and distinctly claiming" the subject matter which the applicant deems to be his invention is the congressional mandate. On this point for example see *Blackford* v. *Commissioner of Patents,* ... F. Supp. ..., 156 USPQ 97 (D. D. C., 1967) where the Court stated at page 98:

> "All too often claims tend to conceal rather than disclose the invention. Claims of the type drafted

by the plaintiff have been encouraged by the Patent Office as far back as 1917."

This conflict with statutory law is an added reason why this Court should grant a review of the decision below.

(b) Infringement

At pages 6 and 7 of the brief, respondents argue that the Court below followed Supreme Court decisions in arriving at the conclusion of file wrapper estoppel based on the fact that narrow specific claims were cancelled in favor of broad allowed patent claims which embraced the substance of the narrow claims within their scope. In this argument the respondents foster the same misinterpretation of the *Schriber-Schroth Co.* v. *The Cleveland Trust Co.*, 311 U. S. 211 (1940) that is inherent in the conclusion of the Court below and set forth 'in 'dicta' in the decided cases referred to at page 12 of the Petition for Writ of Certiorari. The respondents' argument emphasizes the confusion and conflict that exists between those cases upon which it relies and the clear contrary holding of the cases set forth at pages 8 and 9 of the Petition for Writ of Certiorari.

The Schriber case involved the issue of validity of a patent and as such the case loses its logic and direction when applied to the different issue of infringement of valid patent claims which is the present issue under question for review.

In the Schriber case at page 222 the Court estopped the patentee from reading "flexible webs" of narrow cancelled claims back into the broad allowed patent claim to "webs" in order to save the claim from anticipation by the prior art. The same issue of validity was presented in the cases which the Supreme Court cited with approval in the Schriber

case. More specifically, in *Leggett* v. *Avery,* 101 U. S. 256, 259, the Court held a reissue patent invalid for claiming an invention which the patentee had specifically disclaimed under the patent laws in existence in 1879. In *Morgan Envelope Co.* v. *Albany Paper Co.,* 152 U. S. 425, 429, "oval" and "oblong" of narrowed cancelled claims could not be read into a broad allowed patent claim to save the claim from invalidity. In *Wm. B. Scaife & Sons Co.* v. *Falls City Woolen Mills,* 209 Fed. 210, 213, the Court refused to limit a broad patent claim to a specific type of filter in order to save the claim from invalidity. In *Computing Scale Co.* v. *Automatic Scale Co.,* 204 U. S. 609, 621, 622, the Court read a limitation into a broad allowed patent claim in order to save the claim from invalidity for anticipation by the prior art. In *Altoona Publix Theatres, Inc.* v. *Tri-Ergon Corp.,* 294 U. S. 477, 493, the Court held a patent invalid because of an improper disclaimer which the patentee had specifically entered in the Patent Office.

As distinguished from these cases, Schmidinger does not desire to read a limitation back into his patent claims and we know of no good reason to force him to do so on the issue of infringement. The issue for determination in this case is whether the doctrine of the above cases having originated within the confine of the issue of validity should be expanded to apply to the different issue of infringement. This question has not yet been faced by the Supreme Court and should be answered to dispel the confusion and conflict that exist in the decisions below as to the proper interpretation of the Schriber case.

The remaining cases cited by the respondents merely reiterate the well known doctrine, that limitations inserted into a claim which result in an allowance over the prior art may not be ignored on the issue of infringement. Thus in *I. T. S. Rubber Company* v. *Essex Rubber Company,* 272

U. S. 429, 438, 439 (1926), allowance of the patent was obtained by narrowing the claims to a lift in which "the concave upper face of the lift lies entirely below a plane tangent to the rear upper edge and breast portion of the lift". In *Smith* v. *Magic City Kennel Club, Inc.*, 282 U. S. 784, 788, 789 (1931), the patent was obtained by narrowing the claims to "a wheel rotatably mounted on and supporting the arm at the projection end thereof". In *Exhibit Supply Co.* v. *Ace Patents Corporation*, 315 U. S. 126, 136, 137 (1942), the patent was obtained by narrowing the claims to elements "embedded in the table". In *Graham* v. *John Deere Co.*, 383 U. S. 1, 33 (1966), the patent was obtained by narrowing the claims to "a rib" and the Court stated the well established rule of estoppel as applied to the issue of infringement that "claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent".

This doctrine is not applicable to the present case where narrow claims were cancelled in favor of broad allowed patent claims 25 and 26.

CONCLUSION

It is believed that the respondents' brief has provided added reasons for granting the Petition for Writ of Certiorari.

Respectfully submitted,

February 1, 1968

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